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10/098,518

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Kouji Yamamoto

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WASHINGTON, DC 20005

EXAMINER

SHERR, CRISTINA O

ART UNIT

PAPER NUMBER

3621

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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3 MONTHS

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |  |  |  |
|------------------------------|--|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/098,518   | <b>Applicant(s)</b><br>YAMAMOTO, KOUJI |  |
|                              | <b>Examiner</b><br>Cristina Owen Sherr | <b>Art Unit</b><br>3621                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-2, 4-6, 8-10, and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-6, 8-10, and 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to applicant's amendment filed November 28, 2006.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 28, 2006 has been entered.
3. Claims 1, 5, 6, 8, 9, 10, 12, 13, and 14 have been amended. Claims 1-2, 4-6, 8-10, and 12-14 are currently pending in this case.

#### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1, 5, 6, 8, 9, 10, 12, 13, and 14, as currently amended, and with respect to the portion of the references specifically cited, have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4-6, 8-10, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al (US 5,638,443).

7. Regarding claim 1 –

Stefik discloses a method of digital rights management (e.g. abstract) in which rights are variable depending on various events such as fees paid (e.g. col 5 ln 62-67), managing user right information indicating the state in which the software program and used and user rights (e.g. col 6 ln 1-5); where all uses of copies of the digital work are controlled and billable (e.g. col 6 ln 12-15); updating the user rights information (e.g. col 13 ln 20-25); where the program is executed according to updated user rights information (e.g. col 13 ln 10-17).

8. Stefik does not use exactly the same terminology as the instant application nor show exactly the same examples of predetermined events, however, it would be obvious to one of ordinary skill in the art to adapt Stefik thus obtaining the instant invention. Additionally, Stefik discloses, teaches or suggests a range of user rights within which user rights are expanded, when a predetermined event occurs. For example: "A digital work is circulated with a ticket (included in the purchase price and possibly embedded in the work) that can be used for a future upgrade." (col 23, ln 23-25). This is one example of user rights that are increased ("upgrade") in response to an event (use of the ticket). Further, Stefik discloses wherein information is acquired regarding a predetermined range of user rights, defined in the agreement, within which the user rights are expanded. (e.g. fig. 15 lines 1504-1509, col 3 ln 57-67, or "A key feature of the present invention is that usage rights are permanently "attached" to the

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digital work. Copies made of a digital work will also have usage rights attached. Thus, the usage rights and any associated fees assigned by a creator and subsequent distributor will always remain with a digital work” at col 5 ln 53-67, obviously these rights are predetermined and predefined by the author or owner, and are permanent, such that rights may be increased or upgraded through ticket punching and unpunching or generally through paying more money but only within the range that was predetermined.)

9. Regarding the limitations of claims 2 and 4 -

Stefik discloses decoding user information such as credit information so as to update user rights based on said encrypted information (e.g. fig 3, col 7 ln 21-31); and verifying said information by way of predetermined keys (verification information) (e.g. col 14 ln 38-43).

10. As above, Stefik does not use exactly the same terminology as the instant application nor show exactly the same examples of predetermined events, however, it would be obvious to one of ordinary skill in the art to adapt Stefik thus obtaining the instant invention. Additionally, Stefik discloses, teaches or suggests a range of user rights within which user rights are expanded, when a predetermined event occurs. For example: “A digital work is circulated with a ticket (included in the purchase price and possibly embedded in the work) that can be used for a future upgrade.” (col 23, ln 23-25). This is one example of user rights that are increased (“upgrade”) in response to an event (use of the ticket). Further, Stefik discloses wherein information is acquired regarding a predetermined range of user rights, defined in the agreement, within which

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the user rights are expanded. (e.g. fig. 15 lines 1504-1509, col 3 ln 57-67, or "A key feature of the present invention is that usage rights are permanently "attached" to the digital work. Copies made of a digital work will also have usage rights attached. Thus, the usage rights and any associated fees assigned by a creator and subsequent distributor will always remain with a digital work" at col 5 ln 53-67, obviously these rights are predetermined and predefined by the author or owner, and are permanent, such that rights may be increased or upgraded through ticket punching and unpunching or generally through paying more money but only within the range that was predetermined.)

11. Claims 8-10 and 12-14 are rejected under the same criteria discussed above.

12. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### **Apologies**

13. The examiner acknowledges the request in writing of a interview on this case from the applicant, and very much regrets that time constraints due to weather events in the week of February 11-17, made such an interview impossible. This is in no way a

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reflection of this examiner's general willingness to conduct such interviews. If the applicant so desires, a interview in this case may certainly be scheduled for a future mutually convenient time.

***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.


15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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